

Election of Species Requirement

On page 2 of the Office Action, the Examiner stated that an election of species is required because the subject application allegedly contains claims directed to more than one species of the generic invention. The Examiner stated that these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The Examiner identified three species as follows:

- a) methods of screening compounds in which the signal transducing protein is a cell surface receptor,
- b) methods of screening compounds in which the signal transducing protein is a signal transducer protein, and
- c) methods of screening compounds in which the signal transducing protein is a tumor suppressor protein.

The Examiner stated that applicants are required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable.

The Examiner further required that the reply must also identify the claims readable on the elected species, including any claims subsequently added. The Examiner stated that an argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

The Examiner stated that upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141, and that if claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP §809.02(a).

Applicants: Taka-Aki Sato and Junn Yanagisawa
U.S. Serial No: 09/230,111
Filed: May 17, 1999
page 3

The Examiner then indicated that the following claims are deemed to correspond to the species listed above in the following manner:

species a: claims 27-37, 40-46, 50-62, 65-71, 75, 76;
species b: claims 27-36, 38, 47, 50, 52-61, 63, 72, 75, 76; and
species c: claims 27-36, 39, 48-50, 52-61, 64, 73-76.

The Examiner indicated that the following claim(s) are generic: 27-36, 50, 52-61, 75, 76.

The Examiner alleged that the species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each of the species relates to separate and distinct classes of protein product which would be expected to interact with separate and distinct classes of cytoplasmic proteins. The Examiner alleged that there is no special technical feature which relates separate classes of protein products with each other and therefore methods for screening for compounds which inhibit the formation of complexes between each of the separate classes of protein product and a cytoplasmic protein would be separate and distinct methods. The Examiner further alleged that the interaction between the proteins with a GLGF domain (PDZ domain) and proteins with an SXV domain is known in the art as evidenced by the teachings of Kornau et al. (Kornau, H.-C. et al. Science, 269: 1737-1740, 1995).

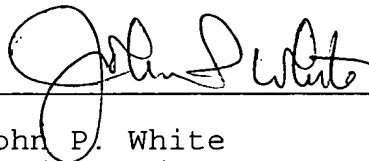
In response, applicants elect with traverse the species identified by the Examiner as species a: methods of screening compounds in which the signal transducing protein is a cell surface receptor. Applicants also identify, as required by the Examiner, the following claims which readable on the elected species: claims 27-37, 40-46, 50-62, 65-71, 75, 76.

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U.S. Serial No: 09/230,111
Filed: May 17, 1999
page 4

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

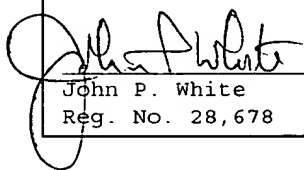
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



John P. White
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6/18/01
Date